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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/976,579	11/24/1997	JAMES D. THORNTON	JAO-34191	2070

7590 02/13/2002

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EXAMINER

DI LORENZO, ANTHONY

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 02/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/976,579

Applicant(s)

THORNTON ET AL.

Examiner

Anthony DiLorenzo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This Office Action is written in response to the amendment and remarks filed on 11/13/01 in the United States Patent and Trademark Office regarding utility patent application serial no.

5 08/976,579. Claims 1-28 have been examined on the merits in light of the presented responses.

The appropriate sections of Title 35 of the U.S. Code not appearing in this communication have been cited in a previous office action.

#### **Amendments**

10 · Specification

Not Amended.

· Drawings

Not Amended.

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· Claims

Claims 1, 10, 19, and 28 are amended as requested by Applicant.

#### **Claim Rejections**

20 Claim rejections are detailed according to each applicable section of Title 35 of the U. S. Code and to each claim below. Rejections of dependent claims necessarily incorporate the rejections of the base claim and any intervening claims. Information contained in rejections of non-related claims may also be incorporated by explicit reference to them. Similar claims are grouped together.

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## · Under 35 USC § 103

## · · Maintained

5 Claims 1-28 are rejected under 35 USC § 103(a) as being unpatentable over Zdybel '686 in view of Durbin '251. The rejections are maintained as they were presented in the office action dated 9/28/01. Detailed citations of the grounds for rejection can be found in said document.

**Response to Remarks**

10 Applicant's traverse of the rejections under section 103 has been carefully considered but is not persuasive. The traverse was based on the amended claim language, which added the limitation of the list being one of "decoded" tokens, as opposed to an unmodified recitation of tokens in the previous version of the claims. Applicant argues that the references do not show generating a list of *decoded* tokens. Applicant further states that the secondary reference, Durbin, recites a display device that shows bar codes that have not been decoded. Examiner disagrees. It is noted  
15 that there is no limiting definition of the term decoding on the record. A thorough review of the specification reveals that the only discussion of this term occurs in a single paragraph on page 7, lines 12-21. The paragraph is part of a description of a preferred embodiment of the invention. However, the cited passage of the specification makes no mention of what it means to decode tokens, only that the segmenter/token decoder 370 decodes the tokens. Further, in Applicant's  
20 traverse, no mention has been made of any definition of the term "decoded."

In the absence of any limiting definition on the record for a term used in the claims, the examiner must give that term the broadest reasonable interpretation in view of the art. Two definitions of the term decoder and one definition of decoding are cited by examiner for the record. See  
25 Microsoft Press Computer Dictionary, page 137, and Newton's Telecom Dictionary, page 305. Each of these definitions supports the conclusion that the invention of Durbin, in converting the printed bar codes into digital representations and displaying them on the screen of the scanning device, is in fact decoding the tokens. For instance, Newton defines a decoder as a device that converts information from one form to another. By converting analog information (the printed

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bar code) into digital information (digital representations of the printed tokens), Durbin generates a list of decoded tokens according to the broadest reasonable interpretation of the term decoded. The traverse was based wholly on the failure of the prior art to teach this feature.

- 5 Examiner also disagrees with Applicant's statement attacking the motivation to combine the references. Applicant states that "because Durbin fails to compensate for the deficiencies in Zdybel, Applicants assert that it would not have been obvious to combine the references..." This is not a proper traverse of the motivation to combine the references, as it is not directed at the motivation cited by examiner in the office action, page 3, lines 21-32. Even if Durbin did fail to
- 10 teach the feature in question, this would not necessarily preclude combinability of the references, as Applicant's statement would indicate.

For these reasons, the rejections have been maintained.

15 **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

20 mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony DiLorenzo, whose telephone number is (703) 306-5617. If the examiner is not available, a voice mail greeting will indicate when the examiner will return to the

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office. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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5 after final faxes (703) 746-7238 other official faxes (703) 746-7239 non-official faxes (703) 746-7240

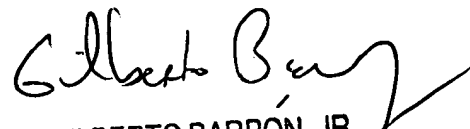
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February 6, 2002

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AD  
2/6/02

  
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ART UNIT ~~222~~ 2132